



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,724	05/23/2000	Vladka Curin-Serbec	201196/50 (80242/US)	3140

7590 11/19/2001

Michael L. Goldman  
NIXON PEABODY LLP  
Clinton Square  
P O Box 31051  
Rochester, NY 14603

EXAMINER

WINKLER, ULRIKE

ART UNIT

PAPER NUMBER

1648

DATE MAILED: 11/19/2001

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/576,724

Applicant(s)

CURIN-SERBEC, VLADKA

Examiner

Ulrike Winkler, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6,10,12-15,17,18 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6,10,12-15,17,18 and 20-31 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1648

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 12-14 and 20, drawn to an antibody and a hybridoma cell line producing the antibody against PrP<sup>Sc</sup>, classified in class 530, subclass 389.1.
- II. Claim 10, drawn to a method of producing an antibody, classified in class 436, subclass 547.
- III. Claim 15, drawn to an anti-idiotypic antibody, classified in class 530, subclass 388.1.
- IV. Claims 17 and 18, drawn to a peptide, classified in class 530, subclass 327.
- V. Claim 21, drawn to a method of immunization using an anti-idiotypic antibody, classified in class 424, subclass 131.
- VI. Claims 22 and 23, drawn to a method of immunization using a peptide, classified in class 436, subclass 543.
- VII. Claim 24, drawn to a method of diagnosing BSE, classified in class 435, subclass 7.1.
- VIII. Claim 25, drawn to a method of treating BSE, classified in class 424, subclass 9.2.
- IX. Claim 27, drawn to a kit for diagnosing BSE, classified in class 435, subclass 810.
- X. Claim 28, drawn to a kit for immunizing an individual against BSE using an anti-idiotypic antibody, classified in class 435, subclass 810.
- XI. Claim 29 and 30, drawn to a kit for immunizing an individual against BSE using a peptide, classified in class 435, subclass 810.
- XII. Claim 31, drawn to a kit for treating an individual against BSE using an antibody, classified in class 435, subclass 810.

Art Unit: 1648

The inventions are distinct, each from the other because of the following reasons:

Groups I, III, IV and IX-XII are compositions and are distinct from groups II and V-VIII which are drawn to methods. Groups I, II, IV and IX-XII are compositions and each is distinct from the other because they contain different materials. Group I comprises an antibody that recognizes PrP<sup>Sc</sup>, antibodies are proteins are made up of amino acids. Group III comprises an antibody that recognizes the mirror image of the PrP<sup>Sc</sup> antibody. Though there may be overlap between groups I and III, in that both groups are drawn to antibodies, the antibodies of each group recognize structurally different epitopes. Group IV is drawn to a peptide, although peptides are made up of amino acids they are different from antibodies which have a distinct shape and functionality. Groups IX-XII are drawn to kits, each is distinct from the other because they contain different components and each combination of elements has a different function. Though there may be overlap for these groups, the search for one group will not be coextensive with that of the other group indicating restriction is proper.

Groups II and V-VIII are drawn to methods and each is distinct from the other because they utilize different starting materials, therefore the outcomes are not be expected to be the same. Group II is drawn to a method for making an antibody. Group V is drawn to a method of immunizing an animal using an anti-idiotypic antibody, this animal will make antibodies that recognize the prion protein. Group VI is drawn to a method of immunizing an animal with a peptide. Group VII is drawn to a method of diagnosing BSE using antibodies. Group VIII is draw to a method of treating an animal having BSE with an antibody. Each method differs from the other methods by utilizing different starting materials and techniques, the outcome would therefore not be expected to be the same.

Art Unit: 1648

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 703-308-8294. The examiner can normally be reached M-F, 8:30 am - 5 pm.

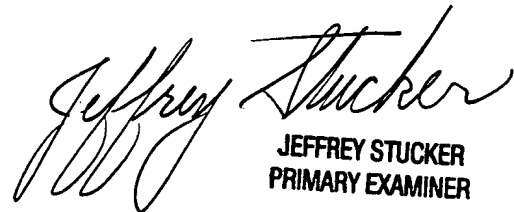
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached at 703-308-4027.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 or for informal communications use 703-308-4426.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Ulrike Winkler, Ph.D.



JEFFREY STUCKER  
PRIMARY EXAMINER